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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,868	09/30/2003	Connie Lim	NEU-5011	6831
27777	7590	01/22/2009	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER
			1619	
			MAIL DATE	DELIVERY MODE
			01/22/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/675,868

**Applicant(s)**

LIM ET AL.

**Examiner**

JYOTHSNA A. VENKAT

**Art Unit**

1619

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2 and 4-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2 and 4-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

Receipt is acknowledged of remarks filed on 11/3/08. Claims 1-2 and 4-8 are currently examined in the application. Claims 3 and 9-20 are withdrawn from consideration as being drawn to non-elected species and non-elected invention respectively.

#### ***Claim Rejections - 35 USC § 103***

Claims 1-2 and 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 4,999,187 ('187) and 6,669,933 ('933).

Instant application is claiming a composition for application to the hair using combination of three conditioning agents drawn to oils. Patent '187 teaches hair treatment compositions using olive oil and almond oil. Oils are known conditioning agents since they provide emolliency to the hair/scalp. See the abstract. Patent at col.1, ll 49-55, col.2, ll 15-30 teaches olive oil and almond oil for scalp. See also claims 1-3. The difference between the patent and the instant application is patent does not disclose meadow foam seed oil as the second conditioning agent and the limitation of claims 7-8 having surfactant into the compositions. However patent '193 teaches compositions for coloring hair. Patent '193 at col.8, ll 25-33 teaches meadowfoam seed oil as the conditioner. Patent '193 at col.14, ll 1-2 teaches adding one or more conditioners that exert conditioning effect on the hair. Patent '193 under example 1, at col.17 and also teaches using meadow foam seed oil. Patent at col.11, ll 4 through col.5, and col.6, line 7 teaches emulsifiers or surfactants.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '187 having olive oil and almond oil and add meadow foam seed oil taught by patent '933 as conditioner oil in analogous hair compositions.

Known work in the field of endeavor, which is hair care in the instant application would prompt one skilled in the hair care art to modify the compositions by having known conditioners since the variations is predictable to one skilled in the hair care art, which is conditioning the hair. With respect to the claimed composition requiring three conditioning agents with three functions: one that penetrates into the core of the hair, one that penetrates into the cortex of the hair but does not substantially penetrate into the core of the hair, and one that does not substantially penetrate into the cortex of the hair, prior art does not disclose claimed function of oils, prior art teaches the same claimed oils as conditioners therefore the oils will have the function of the oil claimed in the instant application .

The use of the term “comprising” permits the presence of other ingredients and does not preclude the presence of other ingredients, active or inactive, even in major amounts. Moleculon Research corp., v. CBS, Inc., 793 F. 2d 1261, 229 USPQ 805 (FED. Cir. 1986); In re Baxter, 656 F. 2d 679, 210 USPQ 795, 803 (CCPA 1981).

### ***Response to Arguments***

Applicant's arguments filed 11/3/08 have been fully considered but they are not persuasive.

Applicants' argue:

“ Vernon relates to a hair treatment composition that may condition in addition to treating dandruff and growing hair. Duffer et al. relate to a hair coloring composition that optionally contains conditioners and surfactants. First, applicants maintain that Vernon and Duffer again represent different product categories -- from each other and from the claimed invention.

Second, applicants do not dispute that oils such as those used in the claimed invention are known, or found in other formulations, and this is all that is taught by the cited references. Rather, applicants have discovered something more -- that different hair conditioning agents chemically affect the hair differently, and that by combining three hair conditioning agents with three different functions, a new and superior hair conditioning composition results. This is explicit in the claims, which require the combination of a first conditioning agent that penetrates into the core of the hair, a second conditioning agent that penetrates into the cortex of the hair but does not substantially penetrate into the core of the hair, and a third conditioning agent that does not substantially penetrate into the cortex of the hair. The identification of the chemical behavior and deliberate combination of different conditioning agents based on such chemical behavior is not found in the prior art “.

In response to the above argument, all the oils are known conditioners. If the first agent penetrates into the core of the hair then the oil does not stop by penetrating only at the core but it penetrates into all the hair. The same is true for second hair conditioning agent that penetrates into the cortex of the hair but does not substantially penetrate into the core of the hair. Specification does not define the scope for “substantially”. Substantially can also be construed that the second conditioning agent also penetrated some oil into the core of the hair. The same is true for third conditioning agent. examiner reviewed example 8 in the specification. Example 8 is drawn to hair that was bleached. How did the three conditioning agents perform when the hair is

not bleached?. Did the conditioning agents perform similarly for unbleached hair, dyed hair, hair that is curled or hair that is relaxed? Hair which is dyed uses different chemicals and this is different from hair that is treated with agents that are used for curling or waving or relaxing hair.

Applicants' admit that the properties of the oils are inherent but argue that art does not teach the combination of three oils. In response to the argument that art does not teach the combination of three oils, one skilled in the hair care art would use the combination of oils with the reasonable expectation of success that a product with combination of three oils provide better conditioning property to hair than a product which has either one type of oil or two types of oils.

In conclusion, the claims are drawn to compositions and the property claimed for all the oils as conditioning agents are inherent since oil and its property are inseparable.

This application contains claims 3 and 9-20 drawn to an invention nonelected with traverse in the reply filed on 2/16/07. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30: 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /  
Primary Examiner, Art Unit 1619